

Remarks

I. Status of claims

Claims 1-15 were pending.

Claims 16-18 have been added.

Claim 10 has been canceled without prejudice.

Claim 1 has been amended.

II. Claim rejections

The Examiner has rejected claims 1-15 of the pending application ("the pending claims 1-15") under the doctrine of obviousness-type double patenting over claims 1-17 and 19-22 of U.S. Application Serial No. 09/785,051, which has issued as U.S. Patent No. 6,928,249 ("the '249 patent"; where claims 1-17 and 19-22 of the '051 application correspond to claims 1-21 of the '249 patent).

A. The Double Patenting Rejection Should Be Withdrawn Because The Examiner Has Failed To Establish A Proper *Prima Facie* Case For The Rejection

The Examiner should withdraw the double patenting rejection of the pending claims 1-15 because the Examiner has failed to establish a proper *prima facie* case of obviousness-type double patenting. In particular, MPEP § 804 B. 1 provides that

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

As explained in detail below, the Examiner has failed to make clear the *differences* between *each* of the pending claims and the invention defined by the claims of the '249 patent, and to make clear the reasons why a person of ordinary skill in the art would conclude the invention defined by each of the pending claims is an obvious variation of the invention defined in a claim of the '249 patent notwithstanding these differences.

For example, the Examiner has not address the fact that none of the claims of the '249 patent recites anything about the preamplifier circuit being operable to linearly amplify an electrical data signal generated by the optoelectronic transducer, as recited in claim 1 of the pending application. In addition, the Examiner has failed to point to any prior art reference or any knowledge generally available to one of ordinary skill in the art at the time the invention was made that provides some teaching or suggestion that would have led one of ordinary skill in the art at the time the invention was made to modify the fiber optic receiver recited in claim 19 of the '249 patent to include a preamplifier circuit that is operable to linearly amplify an electrical data signal generated by the optoelectronic transducer.

The Examiner also has failed to make any effort whatsoever to make clear the differences between *each* of the pending claims 2-15 and the invention defined by the claims of the '249, and to explain why a person of ordinary skill in the art at the time the invention was made would have concluded that the invention defined by *each* of the pending claims 2-15 is an obvious variation of the invention defined by the claims of the '249 patent.

Without making these showings, the Examiner has failed to establish a proper *prima facie* case for rejecting the pending claims 1-15 under the doctrine of obviousness-type double patenting over the invention defined by the claims of the '249 patent. For at least these reasons, the Examiner's double patenting rejection of the pending claims 1-15 over the claims of the '249 patent should be withdrawn.

B. The Double Patenting Rejection Should Be Withdrawn Because The Invention Defined In Each Pending Claim Is Not An Obvious Variation Of The Invention Defined In Any Claim Of The '249 Patent

Each of pending claims 1-15 now recites that the preamplifier circuit is operable to linearly amplify the electrical data signal generated by the optoelectronic transducer over the specified range of optical power for the received optical data signal. None of the claims of the '249 patent recites anything about the preamplifier circuit being operable to linearly

amplify an electrical data signal generated by the optoelectronic transducer. The Examiner has completely failed to address this difference between the pending claims 1-15 and the claims of the '249 patent. Indeed, nothing in the Examiner's rejection provides any factual basis or establishes any motivation for modifying the invention defined by the claims of the '249 patent to incorporate this feature of the invention recited in the pending claims 1-15. For at least this additional reason, the Examiner's double patenting rejection of the pending claims 1-15 over the claims of the '249 patent should be withdrawn.

In addition, each of the pending claims 1-15 recites "an adjustable bandwidth post-amplifier circuit mounted on the substrate." The Examiner has acknowledged that none of the claims of the '249 patent teaches or suggests anything about an adjustable bandwidth post-amplifier circuit. Nevertheless, the Examiner has asserted that:

While the '051 application does not disclose an adjustable bandwidth post-amplifier circuit, it would have been obvious to one of ordinary skill in the art at the time of invention to make the post-amplifier circuit adjustable as in the preamplifier circuit. One is motivated as such since the post-amplifier circuit further amplifies the signal output from the preamplifier circuit, the bandwidth response profile of the post-amplifier circuit should match that of the preamplifier circuit to avoid an uneven gain of signals across a wide bandwidth.

The Examiner, however, has failed to provide any factual basis for his assertion that "since the post-amplifier circuit further amplifies the signal output from the preamplifier circuit, the bandwidth response profile of the post-amplifier circuit should match that of the preamplifier circuit to avoid an uneven gain of signals across a wide bandwidth." The Examiner is requested to cite at least one prior art reference that supports his unsubstantiated assertion. Alternatively, if the Examiner is aware of facts within his personal knowledge that provide the requisite factual basis to support his assertion and establishes the requisite motivation to modify the invention defined by the claims of the '249 patent, the Examiner is requested to provide an affidavit in accordance with 37 CFR § 1.104(d)(2). Otherwise, the Examiner's rejection of the pending claims 1-15 should be withdrawn.

In addition, contrary to the Examiner's assertion, one of ordinary skill in the art at the time the invention was made would not have been motivated to modify the invention defined by the claims of the '249 patent to include an adjustable bandwidth post-amplifier circuit because such an adjustable bandwidth post-amplifier would not be able to properly affect the bandwidth of the data signal unless the pre-amplifier was operable to linearly amplify the

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electrical data signal generated by the opto-electronic transducer. As explained above, however, none of the claims of the '249 patent recites anything about the preamplifier circuit being operable to linearly amplify an electrical data signal generated by the optoelectronic transducer. Thus, for this additional reason, the Examiner's rejection of the pending claims 1-15 should be withdrawn.

For at least these additional reasons, the Examiner's double patenting rejection of the pending claims 1-15 over the claims of the '249 patent should be withdrawn.

III. Conclusion

For the reasons explained above, all of the pending claims are now in condition for allowance and should be allowed.

Charge any excess fees or apply any credits to Deposit Account No. 50-1078.

Respectfully submitted,

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